

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on August 27, 2003, and the references cited therewith.

Claims 1, 8, and 15 are amended consistent with the originally filed specification. These amendments do not add any new matter. As a result, claims 1-20 are now pending in this application.

§101 Rejection of the Claims

The Examiner rejected claims 1-7 and 15-20 under 35 USC § 101 on the bases that the claimed invention is directed to non-statutory subject matter. A patent is not granted for printed matter, naturally occurring articles, scientific principles, or inventions that lack utility. Applicant notes that the Examiner has not asserted a lack of utility rejection, since this rejection requires the Examiner to include specific grounds of inoperativeness for an invention that is believed to be frivolous (e.g., perpetual motion), fraudulent, or against public policy. (MPEP § 706.03(a)).

The Examiner asserts that the body of the method claims (claims 1 and 15) must include technology. Apparently, the Examiner is asserting that the method processing must affirmatively claim software instructions in the body of the method claim, even though the preambles and the amended preambles of claims 1 and 15 clearly assert that the method is carried out as instructions within a computer-readable medium. Applicant respectfully asserts that the Examiner has misapplied § 101 and has misinterpreted the law associated with the effect of preamble language with respect to the claim as a whole.

First and foremost, the Examiner's assertion that the claims do not positive recite technology is inaccurate. Claims 1 and 15 clearly recite processing steps related to the technology of optimizing a campaign and a campaign contact list.

The Examiner's attention is directed to MPEP 2106(c)(2), where it is stated that for "for purposes of a 35 U.S.C. 101, analysis, it is of little relevance whether the claims is directed to a machine or a process. Emphasis added. The legal principles are the same. *AT&T Corp. v. Excel Communications, Inc.* Claims 1 and 15 are processes, there are no

statutory requirements that these processes be embodied in machines or with any other structure, although Applicant's claims 1 and 15 clearly are directed towards machines that process the executable instructions, which reside in computer-readable media.

The structures in Applicant's preambles are sufficient to provide structure for the claim bodies. Once again, the Examiner's attention is directed to MPEP 2111.02 "Effect of Preamble." Here it is stated: "any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." Emphasis added.

Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1252, 1257 (Fed. Cir. 1989). There is little doubt that claims 1 and 15 recite structure, namely executable instructions residing in a computer-readable medium and that this structure limits the positively claimed processing language of claims 1 and 15 to computer implemented embodiments. The entire MPEP section 2106 discusses permissible software inventions, which include data structures where only the preambles of the data structures provide any structure. Structure is not a requirement for process claims, although claims 1 and 15 clearly have that structure with their preambles and there is nothing more that is required by law.

The test the Examiner must use with respect to § 101 is whether the claim as a whole produces a useful concrete and tangible result. It has long been established that software implementations including programs and codes embodied in a computer media are inventions that are entitled to patent protection and thus are considered patentable subject matter. (*In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) (*en banc*)). In fact, if a claimed invention as a whole produces a useful concrete and tangible result, then the invention is patentable. (*State Street Bank & Trust v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998)). Thus, even business methods embodied in a computer media are properly classified as processes entitled to patent protection under § 101.

Since it has long been established as a matter of settled law that software inventions embodied in computer media can be patentable, Applicant assumes that this is not the core rationale behind the Examiners newly issued § 101 rejection with this Office Action. Again, the goal of the Examiner is to determine what the Applicant invented. Here, very clearly stated in the claim preambles of claims 1 and 15, the Applicant has

stated the claims are directed to optimizing a campaign or a campaign contact list by using executable instructions within a computer-readable medium, that when executed performs the methods. Thus, very clearly the claims are directed on their face toward patentable subject matter, since the claims are embodied in a computer medium and the claims are directed to optimizing a campaign or a campaign contact list by using executable instructions processed in that computer-readable medium. The structure of executable instructions within a computer-readable medium which are present in the preambles are limitations on the structure of the claims, pursuant to settled law.

Furthermore, the courts have with unanimity held that § 101 limitations are to have very limited scope and application, and that the phrase “new and useful process, machine, manufacture, or composition of matter” shall have a very broad and expansive meaning to reflect Congress’s intent when enacting the patent laws. To enforce this interpretation the courts have held that the Examiner has the burden of establishing a *prima facie* case that the claimed invention as a whole is directed solely to an abstract idea or to manipulate abstract ideas that do not produce a useful result. Moreover, the Examiner must expressly state how the claim language is being used to support his/her § 101 rejection. Furthermore, only when a claim is devoid of any limitation to a practical application in the technological arts should it be rejected under § 101. (*In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994).

Applicant has demonstrated, even without the above amendments to claims 1 and 15 that the language of claims 1 and 15 are embodied in computer media and do produce practical results. As a further example, the Examiner’s attention is directed to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999) where the Court stated “transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces a ‘useful, concrete and tangible result’.”

Thus, Applicant asserts that the Examiner has misapplied § 101 and misinterpreted the law with respect to the effect of a claim’s preamble. Claims 1 and 15 are directed to useful and concrete results, they are processed in a computer-readable

medium (although not required to do so) and these structures are clearly recited in the preambles which are positive and structural limitations of the overall claims.

Accordingly, the rejections with respect to claims 1-7 and 15-20 are not sustainable and should be withdrawn.

§102(e) Rejection of the Claims

The Examiner rejected claims 1-7 as being anticipated under 35 USC § 102(e) by U.S. Patent No. 6,240,411 (hereinafter “Thearling”). It is fundamental that in order to sustain an anticipation rejection each and every step or element in the rejected claims must be taught or disclosed in the cited reference.

Applicant incorporates by reference the previous arguments of record. The Examiner has asserted that Applicant’s previous arguments do not correspond to Applicant’s claim language, and, therefore, Applicant’s argument that Thearling fails to teach how to alter an algorithm is unclear as to its relevance. Consequently, Applicant has amended independent claims 1, 8, and 15, consistent with the original filed specification, such that now these independent claims clearly indicate that the outside environmental changes affect the correlation being used with the campaign. Clearly, this now demonstrates how campaign optimization is altered based on the influence of environmental changes occurring outside the campaign, since these changes affect the correlation.

With respect to Thearling, Applicant again reiterates that there is no teaching in Thearling that adjustable time intervals or contact intervals are associated with environmental changes occurring outside the campaign as the Examiner has asserted with reference to column 7 lines 60-65 of the Thearling reference. A complete reading of this reference in context actually proves the opposite of what the Examiner is asserting. That is, Thearling maintains that other (known) techniques perform data mining outside the scope of the campaign and that this is inefficient and undesirable to do. Emphasis added. Thearling, col. 7 line 56 through col. 8 line 11.

In fact, this reference used in support of the Examiner’s conclusion that Thearling teaches using adjustable or contact intervals associated with environmental changes

occurring outside the campaign, suggest that such a teaching is not desirable and one of the situations that the Thearling reference is designed to correct. Thus, contrary to the Examiner's assertion this reference teaches away from and against adjustable or contact intervals associated with environmental changes occurring outside the scope of the campaign. Therefore, Thearling specifically teaches away from Applicant's independent claims and cannot be said to anticipate them.

Furthermore, Applicant's amended independent claims now recite a correlation that is affected by the environmental changes that occur outside the scope of the campaign. The correlation is core to the campaign. There is no evidence or teaching in Thearling that the scoring (algorithm) is altered based on the delay or increase in time to pursue another implementation of the standard algorithm. Thearling's alternative implementations may increase or decrease time for a calculation to process a score, but the elapsed time does not affect the score as suggested by the Examiner. Time is an incidental consequence of processing the algorithms in Thearling, but time does not affect the outcome of the algorithms in Thearling. Moreover, there is no support for any reasonable inferences that can be drawn from Thearling in order to support the Examiner's current conclusion.

Conversely, Applicant's invention is directed to using time or intervals to directly impact and affect correlations of a campaign. Thus, Applicant asserts that Thearling does not teach intervals or time periods that affect correlations as is recited in Applicant's amended independent claims.

Accordingly, the present claims should be allowed to issue and the rejections withdrawn.

§103(a) Rejection of the Claims

The Examiner has rejected claims 8-20 under 35 U.S.C. 103(a) as being obvious by Thearling in view of the Barron's Dictionary of Marketing Terms (hereinafter "Baron"). In order to sustain an obviousness rejection each and every step or element in the rejected claims must be taught or suggested in the cited references. Here, neither Thearling nor Barron in isolation or in combination teach adjustable or contact intervals

associated with environmental changes occurring outside the scope of the campaign,

where those environmental changes affect the correlation, as is recited in Applicant's amended independent claims. Thus, the obviousness rejections should be withdrawn.

In this rejection, the Examiner admits that the Thearling reference fails to teach adjustable time intervals associated with environmental changes occurring outside the scope of the campaign. Applicant agrees that Thearling does not teach this limitation and in fact based on the remarks presented above that Thearling actually teaches away from this limitation.

Accordingly, the Examiner relies on Barron for this limitation. The Examiner asserts that by definition a campaign occurs over a given period of time. Based on this it is asserted that Thearling inherently includes Applicant's claimed adjustable or contact intervals. However, Applicant would like to point out that the Examiner is using improper hindsight in this conclusion. The Barron reference at best defines a single period of time, namely the life of the campaign defined by a campaign beginning and a campaign ending. The Barron reference does not teach multiple configurable and discrete units of time defined as adjustable or contact intervals (plural periods of time).

Essentially, the Examiner is asserting that because a campaign occurs over a single discrete period of time, that the Thearling reference would know that it would be beneficial to break that contiguous period of time up into configurable sub and adjustable intervals, where during each interval adjustments are made to the campaign to optimize the campaign based on environmental changes occurring outside the scope of the campaign. Applicant disagrees with this logic. Traditionally, time has been used to define the beginning and end of a campaign. Time has not been used and is not used in Thearling or in Barron as a technique that can be dissected into adjustable intervals and evaluated in order to affect the substance of the campaign, namely the correlation as is recited in Applicant's amended independent claims.

The Examiner has used examples where a campaign time is altered; the examples that are used reflect events that are wholly contained within the scope of the campaign, and not for environmental changes outside the scope of the campaign. For example, the Examiner asserts that meeting a sales goal or a revenue goal would alter the time. These

AMENDMENT AND RESPONSE

Serial Number: 09/604,503

Filing Date: June 27, 2000

Title: METHODS AND SYSTEM FOR OPTIMIZING A CAMPAIGN

Page 13

Dkt: NCR 8636 (1592.017US1)

are factors within the scope of the campaign, and the time altered is the ending time for the campaign. These examples are not for environmental changes occurring outside the scope of the campaign that are altering the correlations of an ongoing campaign.

Thus, Applicant cannot agree with the Examiner's conclusions and assessments. Furthermore, Applicant continues to assert that Thearling standing alone or standing in combination with Barron does not teach and does not suggest each and every step and element of Applicant's independent claims. Therefore, Applicant respectfully requests that these rejections be withdrawn and the claims be allowed.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((513) 942-0224) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No.19-0743.

Respectfully submitted,

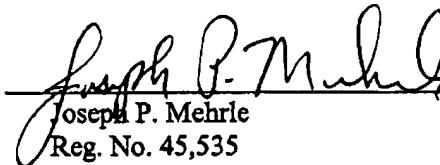
John E. Montague

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
513-942-0224

Date 11-24-03

By


Joseph P. Mehrlie
Reg. No. 45,535

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of November, 2003.

Name

Amy Moriarty

Signature

